



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,622	12/31/1999	Howard Chin	884.101USI	8079

7590 10/28/2002

Schwegman Lundberg Woessner & Kluth PA
P O Box 2938
Minneapolis, MN 55402

EXAMINER

TREAT, WILLIAM M

ART UNIT	PAPER NUMBER
----------	--------------

2183

DATE MAILED: 10/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/476,622

Applicant(s)

Chin et al.

Examiner

W. TREAT

Group Art Unit

DW2183

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

10-27-02

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 (one) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/21/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 10 and 21-40 is/are pending in the application.
- Of the above claim(s) 10 and 21-40 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☐ Claim(s) is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 2183

1. Claims 10 and 21-40 are presented for examination.
2. Newly amended claim 10 and previously restricted claims 21-40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- Applicants specification identifies the invention of their newly amended claim 10 and previously restricted claims 21-40 as a distinct invention from the original claims 1-20.

On page 4, line 25 through page 5, line 3, applicants state: "Fig. 2A is a more detailed block diagram of an example embodiment of the processor and firmware shown in Fig. 1. In one embodiment of the invention, firmware 206 stores program code 210 for controlling the operation of the processor 204. The programmed code 210 stored in the firmware 206 is referred to herein as the 'firmware code.' In an example embodiment, the firmware code 210 implements microcode operations using registers which are specific to a particular machine or to a particular model of a machine. The registers are referred to herein as 'Machine Specific Registers.' The machine specific registers function as an interface between the firmware 206 and the processor 204." Applicants newly amended claim 10 and previously restricted claims 21-40 are all directed to this new invention requiring machine specific registers.

On page 5, line 25 through page 6, line 4, applicants state: "Fig. 2B is a block diagram of an alternate embodiment of the processor shown in Fig. 1 and external microcode stored in a computer readable medium. In one embodiment of the invention, a computer readable medium 220, which is external to the processor, stores program 222 for controlling the operation of the

Art Unit: 2183

processor 224. Examples of computer readable mediums external to the processor include, but are not limited to, mass storage devices, firmware, and memory. The programmed code 222 stored in the computer readable medium is referred to herein as 'external microcode.' In an example embodiment, the external microcode 222 implements microcode operations by controlling hardware logic on the processor 224 without the use of the registers (i.e., the machine specific registers) shown in Fig. 2A." Applicants' original claims were all directed to the alternative invention without machine specific registers.

Because these inventions are distinct for the reasons given above and the search required for amended claim 10 and previously restricted claims 21-40 was not required for the original claims, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, amended claim 10 and previously claims 21-40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Applicants have argued that the language of original claims 5, 6, 7, 11, 15, and 18 was directed to "machine specific registers", and therefore, the examiner should not restrict their new claims specifically reciting "machine specific registers" as being directed to the different invention as explained by the examiner in paragraph 2, *supra*. The examiner notes that claims 5, 6, 7, 11, 15, and 18 were all canceled by applicant in response to art that did not teach "machine

Art Unit: 2183

specific registers". The cancellation of those claims in response to art which did not teach "machine specific registers" is a tacit admission that applicants' original claims were not directed to the alternative invention with "machine specific registers".

4. The amendment filed on 10/21/02 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03).

The remaining claims are not readable on the elected invention because of the reasons set forth in paragraphs 2 and 3, *supra*.

Since the above-mentioned amendment appears to be a bona fide attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William M. Treat whose telephone number is (703) 305-9699. The examiner works a flexible schedule, but he can normally be reached during the afternoons and evenings on four of the five weekdays.



**WILLIAM M. TREAT
PRIMARY EXAMINER**